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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,363	03/17/2000	Mason Ng	40827.00039	4258
30256	7590	03/27/2003		
SQUIRE, SANDERS & DEMPSEY L.L.P 600 HANSEN WAY PALO ALTO, CA 94304-1043			EXAMINER	
			LIN, KENNY S	
ART UNIT	PAPER NUMBER			
	2154			
DATE MAILED: 03/27/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	S
	09/528,363	NG ET AL.	
	Examiner Kenny Lin	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 September 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) 9-14 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-14 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2-6</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. Claims 1-14 are presented for examination. Claims 1-8 have been elected without traverse by the applicant.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, Group I, drawn to System for multicomputer data transferring demand based messaging, classified in class 709, subclass 206.
  - II. Claims 9-12, Group II, drawn to System for multicomputer data transferring client and server, classified in class 709, subclass 203.
  - III. Claim 13-14, Group III, drawn to Software upgrading including distribution of software, classified in class 717, subclass 172.
3. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as storing a copy of user preferences and checking if any changes have been made to the copy of user preferences and invention III has separate utility such as downloading files to a requesting computer; these are patentably distinct features not found in invention I. See MPEP § 806.05(d).
4. Because these inventions are distinct for the reasons given above and the searches required for Group I is not required for Groups II or III, for Group II is not required for Groups I

or III and for Group III is not required for Groups I or II, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Mr. Marc Sockol on March 14, 2003 to request an oral election to the above restriction requirement. On March 15, 2003, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8 on a voice mail left by Mr. Marc Sockol. Affirmation of this election must be made by applicant in replying to this office action.

### **Specification**

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to because fails to fall within the range of 50 to 150 words. Correction is required. See MPEP § 608.01(b).

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 3-4 rejected under 35 U.S.C. 102(e) as being anticipated by Moon et al (hereinafter Moon), US Patent 6,138,146.

10. As per claims 3-4, Moon taught the claimed invention including a method, comprising:

- Establishing a communication channel with a client computer system (col.3, lines 61-67, col.4, lines 1-8);
- Receiving information corresponding to new email events from the client computer system (col.4, lines 22-25, 30-34, 54-63); and

- c. Storing the information corresponding to the new email events in a database (col.4, lines 30-34, 54-63).

11. Claims 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165.

12. As per claims 5-6, Narasimhan taught the claimed invention including a method comprising:

- a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
- b. Examining email data against the filter control data (col.5, lines 3-17);
- c. Determining at least one transfer protocol for the email data based on the examination (col.5, lines 42-49, col.6, lines 40-56); and
- d. Forwarding the email data according to the at least one transfer protocol via a computer network to a database (col.6, lines 19-21, 40-56).

### **Claim Rejections - 35 USC § 103**

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (hereinafter Chen), US Patent 6,510,455, in view of Paarsmarkt et al (hereinafter Paarsmarkt), US Patent 6,118,856.

15. As per claims 1-2, Chen taught the invention substantially as claimed including a method, comprising:

- a. examining start criteria (col.6, lines 12-22);
- b. determining whether the start criteria have been met (col.6, lines 12-22, 25-31);  
and
- c. obtaining new email events from an email database after the start criteria have been met (col.6, lines 25-52).

16. Chen did not specifically teach the method to forward information corresponding to the new email events via a computer network to a database. However, Paarsmarkt taught an email system to forward information or portion of information corresponding to the new email events via a computer network to a database (col.2, lines 15-17, 25-29, 48-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Paarsmarkt because Paarsmarkt's teaching of forwarding information or portion of information enables users to specify condition for forwarding received email to a remote device in Chen's email system.

17. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US Patent 6,138,146.

18. As per claims 7-8, Narasimhan taught the invention substantially as claimed including a method, comprising:

- a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
- b. Examining email data against the filter control data (col.5, lines 3-17); and
- c. Determining based on the examination the email data that should not be forwarded (col.2, lines 3-6, col.5, lines 3-23);
- d. Generating receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.6, lines 11-18); and
- e. Forwarding the receipt data via a computer network to a database (col.6, lines 19-21, 40-56).

19. Narasimhan did not specifically teach the step of generating receipt data identifying the email data that should not be forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.6, lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be forwarded. Moon taught to identify the email data that should not be forwarded and send the email data that should not be forwarded

back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block.

### **Conclusion**

20. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Owens et al, US Patent 6,023,700, disclosed email filtering.

Fleming, III, US Patent 6,249,805, disclosed filtering unauthorized email.

Shinomura et al, US Patent 6,108,709, disclosed selective email forwarding.

Paul, US Patent 5,999,932, disclosed unsolicited email filtering.

Weber et al, US Patent 5,878,230, disclosed email forwarding and routing.

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22. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. Additionally, the fax numbers for Group 2100 are as follows:

Official Responses: (703) 746-7239

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-5140.

ksl  
March 19, 2003

  
ZARNI MAUNG  
PRIMARY EXAMINER